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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/344,323	06/24/1999	RICHARD G. HARTMANN	EN998070	8931

7590 11/16/2004

IBM CORPORATION - DEPT. 917  
3605 HIGHWAY 52 NORTH  
ROCHESTER, MN 55901-7829

EXAMINER
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NGUYEN, HAI V

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/344,323  
Filing Date: June 24, 1999  
Appellant(s): HARTMANN ET AL.

HARTMANN ET AL.  
For Appellant

**EXAMINER'S ANSWER**

**MAILED**  
NOV 16 2004  
Technology Center 2100

This is in response to the appeal brief filed 15 September 2004.

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**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 1-20 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

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**(9) Prior Art of Record**

<b>6,223,188</b>	ALBERS ET AL	4-2001
<b>6,366,933</b>	BALL ET AL.	4-2002

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-20 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 02 April 2004.

**(11) Response to Argument**

Issue (A) The prior art does not disclose, "*A predetermined, user defined configuration of Profile Consisting of Data Type and/or Size*" in claims 1,2,11-17 (*Appellant's Brief, page 9 of 27*).

As to point (A), Albers discloses that "*if no information is desired about the audio menu, the user may set several different parameters to configure the system to provide auditory cues (Albers, Fig.9, col. 7, lines 39-51), and the selections made by user are then implemented or the menu is dismissed without making the indicated changes in configuration (if any) Albers, (Fig. 9, col. 7, lines 52-60), and the selection process may be controlled by user selection or predefined parameters, or the system may simply select all links currently displayed (Albers, Fig. 10, col. 8, lines 8-21)*" and In figure 7, Albers indicates to the user the data file's type and size (Fig. 7, items 730 , 740).

Issue (B) Appellant argued, "*The Asserted Motivation to combine the prior art is based on Hindsight*" (*Appellant's Brief, page 12 of 27*).

As to point (B), in response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Issue (C), Appellant argued that "*Examiner is using Appellant's own teachings to provide motivation*" (*Appellant's Brief*, page 13 of 27).

As to point (C), in response to Appellant's argument that Examiner uses Appellant's own motivation. In this instant application, Examiner does not either use Appellant's disclosure to make up for the motivation or suggestion to combine the references or make up his reasons for combination of references.

As a matter of fact, "Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Albers' teachings of using HEAD request to efficiently provide information on hypermedia links without forcing the user actually download the information represented by those links (*Albers*, col. 2, lines 11-20) with the teachings of Ball, for the purpose of allowing users to specify lists of documents of interest (*Ball*, *Abstract*, Fig. 13; col. 2, lines 39-45; col. 4, lines 44-51; col. 21, lines 37-50). Ball also suggests that *existing GET and POST protocols are used to communicate with specific servers that save versions of*

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*documents and provide mark-up versions showing how that have changed. However, if a server runs htldiff and some perl scripts, it can provide a direct version-control interface and avoid the need to store copies of its HTML documents elsewhere (Ball, col. 21, lines 5-12) and reducing network traffic and users' time and resources (Albers, col. 5, lines 24-39)" (in the Final Rejection mailed on 02 April 2004, on pages 4, 5).*

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Hai V. Nguyen  
Examiner  
Art Unit 2142 *HN*

Hai V. Nguyen  
November 10, 2004  
*HN*

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